

REMARKS

Claims 1-27 are pending in the application. Reconsideration in view of the amendment to the specification and following remarks is respectfully requested.

35 U.S.C. §112 Rejection

The Examiner rejected claims 1-27 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description. The Examiner rejected claims 1-27 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Applicant traverses these rejections.

Applicant directs the Examiner's attention to supporting and enabling portions of the disclosure which Applicant previously cited (e.g., pages 8-11 and Figure 2A-2D). These cited passages and Figures are referring (also as previously conveyed) to then co-pending U.S. Patent Application Serial Number 09/199,150, now issued as U.S. Patent No. 6,751, 670, filed November 24, 1998, incorporated by reference, as originally filed. This incorporation by reference is in compliance with MPEP §2163.07(b), which states, in part:

Instead of repeating some information contained in another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. (Emphasis added)

As such, since the incorporated information is as much a part of the original application as filed as if the text was repeated in the application per MPEP §2163.07(b), Applicant submits that support for the invention as claimed is indeed described and enabled by the specification as originally filed.

The Examiner also cites MPEP 608.01(p) apparently in an attempt to establish that an incorporation of material from the co-pending application (Serial No. 09/199,150) has not been accomplished in this application for the purpose of the disclosure required by 35 U.S.C. §112, first paragraph. The section of MPEP 608.01(p) cited by the Examiner states, in part:

“Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. §112, first paragraph. In re Serversky, 474 F.2d 671, 177 USPQ 144 (CCPA 1973)...”

Applicant submits that if the Examiner is asserting that *In re Serversky* establishes that “incorporation by reference” is not an incorporation of material for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph, then Applicant respectfully disagrees. Rather, *In re Serversky* addresses the situation where a reference (i.e., a mere reference) is made but the reference is not an incorporation by reference. The issue in *In re Serversky* deals with simple references such as a reference to another patent or application (e.g., a continuation-in-part reference) without incorporation by reference. In the *Serversky* situation, incorporation of material has not been accomplished for the purpose of 35 U.S.C. 112, first paragraph. Further, *In re Serversky* actually confirms that a proper incorporation by reference does indeed provide for incorporation of material for the purpose of the disclosure required by 35 U.S.C. §112, first paragraph. This is stated *In re Serversky*, quoting *In re Lund*, 54, CCPA 1361, 376, F.2d 982, (1967):

“As the expression itself implies, the purpose of “incorporation by reference” is to make one document become a part of another document by referring to the former in the later *in such a manner* that it is apparent that the cited document is part of the referencing document as if it were fully set out therein.” (Emphasis in original)

Since MPEP §2163.07(b) and MPEP 608.01(p) (along with *In re Serversky*) affirm Applicant’s assertion that subject matter, properly incorporated by reference, is a part of the specification as originally filed, Applicant also submits that various aspects and features are indeed described and enabled in the specification as originally filed, since a proper incorporation by reference was made in the present application as originally filed.

In particular, the Examiner asserts that the specification does not provide a written description nor enables one skilled in the art to make/or use the invention comprising “wherein the instructions are executable instructions and collect the notification information and selectively deny access to the requested data until notification is transmitted.” Also the Examiner asserts that “Applicant has failed to cite sections of co-pending application where the newly added limitations regarding notifications (e.g., transmittal, collection, access control via notifications) can be found. Applicant respectfully draws the Examiner’s attention to the fact that these sections were clearly identified in the last Amendment submitted February 25, 2004 at page 7, first paragraph, which states, in part:

“Support for the amendments may be found at least at page 7, ll. 13-31, and page 11, line 26 to page 12, line 24 and Figures 2A-4 of the subject matter incorporated by reference as originally filed.”

In view of the above, Applicant submits that support for transmittal, collection, access control via notifications was indeed previously cited and additional support may be found throughout the then co-pending application, which was incorporated by reference as originally filed in the present application.

Since U.S. Patent Application No. 09/199,150 has now issued as U.S. Patent No. 6,751, 670, Applicant has amended the specification to reference the now issued U.S. Patent No. 6,751,670 in the specification.

Since the disclosure fully complies with the written description requirement and complies with the enablement requirement of 35 U.S.C. 112, first paragraph, Applicant submits that the 35 U.S.C. 112 rejections should now be withdrawn.

35 U.S.C. §101 Rejection

The Examiner rejected claims 1-27 under 35 U.S.C. §101 because the disclosed invention is inoperative and therefore lacks utility. Applicant respectfully traverses this rejection.

Independent claim 1 (other independent claims recite similar variations) recites, in part:

“transmitting notification when the requested data is accessed, wherein the instructions are executable instructions and collect the notification information and selectively deny access to the requested data until the notification is transmitted.”

The Examiner however asserts that:

“Here, since a notification is not transmitted until the user access the requested data, and since a user may not access data until a notification information is transmitted, the system is inoperative to provide the user access to said data.”

However, Applicant respectfully disagrees with the Examiner’s circular argument that the invention as claimed lacks utility. Applicant submits that the claimed invention is indeed operational when all the words of the claimed invention are considered. In particular, “selectively deny access to the requested data” (e.g., electronic content) imparts a distinction to the meaning of the claimed invention that at least certain operations such as, for example, viewing, listing, saving, printing, or the like, may be selectively denied, and alternatively, access may be selectively denied to parts of the requested data while other parts may be accessed. This is consistent with the disclosure (U.S. Patent No. 6,751,670) which may be found at least at col. 1, ll. 43 -45. At this passage, disclosure provides that executable instructions may deny access until notification information is transmitted successfully. At col. 3, ll. 5-13 this passage discloses that access to electronic content is selectively granted based on the transmission of the notification information. Also, col. 1, l. 64-67 discloses that the electronic contents may be multiple files of data, text, audio, video, etc. and, when read in view of the passage at col. 2, ll. 41-48, where it states that access is selectively granted to the electronic content based on the result of the

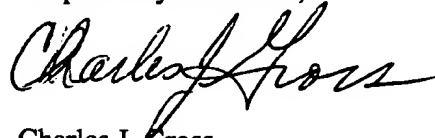
transmission of the notification information, it is also apparent that access to parts of the electronic data may be selectively granted (e.g., or selectively denied).

As can be readily determined, "selectively deny" imparts a distinction that some actions (e.g., viewing, listing, etc.) on the electronic data and/or gaining access to some portions (e.g., different files such as text, video, data, audio, etc.) of the electronic data is either restricted or not. This, therefore, provides for the operability of claims 1-27 wherein some aspects of the electronic data may be accessed while others may not and Applicant submits that the invention as claimed is indeed operational and has utility when all the words and phrases of the claims are considered (e.g., selectively). Thus, Applicant submits that the 35 U.S.C. §101 rejection should now be withdrawn.

Conclusion

In view of the foregoing remarks, Applicant submits that all of the rejections and objections have been rendered moot. Applicant submits that all of the claims are patentably distinct from the prior art of record and are in condition for allowance and that the application should now be passed to issuance. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written petition for extension of time if needed. Please charge any deficiencies and credit any overpayment of fees to Attorney's Deposit Account No. 23-1951.

Respectfully submitted,



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